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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/924,943

08/09/2001

Tadao Kanuma

040679-1324

1999

22428 7590 02/09/2007
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EXAMINER

SINGH, ARTI R

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

02/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/924,943	Applicant(s) KANUMA, TADAO	
	Examiner Ms. Arti Singh	Art Unit 1771	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



Ms. Arti Singh
Primary Examiner
Art Unit: 1771

Continuation of 5. Applicant's reply has overcome the following rejection(s): If the proposed amendments were entered then, Applicant's remarks/amendments overcome the objections made in over the specification in paragraph 2 and 3 of the previous office action..

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's first traversal is that the cited combination of Tsuji and Kami fail to teach or suggest the second silicone to be found at the junction and interposed between the silicone layers. In rebuttal, Applicant is directed to column 7, Example 4, where they teach that the silicone rubber coated fabric was produced by coating the silicone rubber based coating composition on fabric made of Nylon 66 fiber (420 denier) using a coater to apply the minimum amount permitting uniform coating without irregularities and then curing it by heating for 2 minutes at 180.degree. C. in a heating oven-this is equivalent to the first silicone layers that Applicant desires.. After superimposing the coated surfaces of the coated fabric, applying a room temperature curable silicone rubber adhesive agent - RTVis applied "therebetween" -EMPHASIS ADDED, and allowing the fabric to stand at room temperature for 7 days-this is equivalent to the second silicone that Applicant desires. Thus this disclose the "interposed layer" to be found "therebetween the first silicone layers" and this traversal is found to be unpersuasive. Applicant's second traversal is that the coating that is used is different than that of Applicant, this is also not found to be persuasive as in column 3 the instant patent discloses using dimethylpolysiloxane which is exactly the same as what Applicant's specification states is the silicone of choice. Additionally, with regard to the resultant mechanical properties of hardness and fractural elongation, the position of the Examiner is maintained, in that if structurally and chemically the exact composition is being used, then when tested against any standard the results should be the same or slightly different (In re Fitzgerald/Best).

It should be noted that when Applicant's traversal is that the Examiner has not established a prima facie showing of obviousness because the prior art fails to teach the problem or the source of the problem solved by the claimed invention; and that Applicant's invention is directed to solving the problem. To this the Examiner rebuts that when a Fitzgerald/Best type of 103 rejection is applied, it is not the normal 103 rejection where a Graham V. Deere obvious determination is made. In these types of 103 rejections, the Examiner has stated that as "best we can tell, given the information available" the product of the prior art is the same as that set forth in the claims and that if there is any difference, it would be an obvious variation due to vagaries of processing conditions, different test methods etc. and that the difference would not be significant if not the same. The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentable new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Additionally, a rejection made under 35 U.S.C. 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/ 103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. 102/ 103 rejection is appropriate for these types of claims as well as for composition claims. Therefore the Examiner has met her burden of establishing the basis for this type of a rejection by showing that the combination of Kami and Tsuji is both structurally and chemically the same and then shifted the burden to Applicant to refute that it isn't. Furthermore, Applicant's arguments or conclusions are not enough to overcome the cited art or to take the place of evidence. In re Cole, 51 CCPA 919, 326. If Applicant still believes that the Examiner is incorrect in her deduction, please file a declaration proving otherwise.